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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/677,558	09/29/2000	Gi-Young Jeun	29347/990488	1618
7590 10/04/2005			EXAMINER	
Marshall O'Toole Gerstein Murray & Borun 6300 Sears Tower 233 South Wacker Drive Chicago, IL 60606-6402			NGUYEN, DILINH P	
			ART UNIT	PAPER NUMBER
			2814	

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary	Application No.		Applicant(s)	
	09/677,558		JEUN ET AL.	
	Examiner		Art Unit	
	DiLinh Nguyen		2814	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-11 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-11 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-5 and 19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 3 of U.S. Patent No. 6432750. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed device is shown in the patented claims as follows:

Claims 1-5 and 19 correspond to claims 1 and 3.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1-2, 4 and 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Hamzehdoost et al. (U.S. Pat. 5430331) (newly cited).

Hamzehdoost et al. discloses a semiconductor package comprising:

a lead frame 154 having a first portion 152 at a first level, a second portion connected to the first portion at a second level, and a plurality of terminals connected to the second portion;

a power circuit 150 mounted on a first surface of the first portion;

a heat sink 144 or 130 comprising at least one compound selected from the group consisting of AlN and having an electrically insulating property and thermal conductivity, wherein the heat sink directly contacts a second surface opposite the first surface of the first portion of the lead frame; and

a sealer having an electrically insulating property and thermal conductivity, wherein the sealer covers the power circuit (cover fig. and fig. 14A, column 9, lines 17-21).

- Regarding claim 2, Hamzehdoost et al. discloses that the first portion of the lead frame is centrally positioned within the lead frame (fig. 14A).
- Regarding claim 4, Hamzehdoost et al. discloses that the first surface of the first portion is a top surface and wherein the second surface of the first portion is a bottom surface (fig. 14A):
- Regarding claim 10, Hamzehdoost et al. discloses that the heat sink and the sealer each have grooves 132 and wherein the heat sink and the sealer are connected to each other by means of the grooves (cover fig.).

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- Regarding claim 11, Hamzehdoost et al. discloses that the heat sink 130 or 144 is sheet-shaped (cover fig. and fig. 14A).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamzehdoost et al. (U.S. Pat. 5430331) (newly cited) in view of Majumdar et al. (U.S. Pat. 5703399) (previously applied).

- Regarding claims 3 and 5, Hamzehdoost et al. substantially discloses all the limitations as claimed above except for the package comprising a power semiconductor element and a control circuit that drives the power circuit.

However, Majumdar et al. disclose that a lead frame 3 having a first portion at a first level, a second portion surrounding the first portion at a second level, and a plurality of terminals 15 and 17 connected to the second portion;

a power circuit 9 includes a power semiconductor element 4a; and

a control circuit 8 that drives the power circuit (fig. 9, column 7, lines 10-25).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Hamzehdoost et al. by having a power semiconductor element and a control circuit that drives the power circuit, as taught by Majumdar et al., such the power element and control circuit would enhance

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the noise resistance and control the operation of the power circuit (column 7, lines 10-12).

- Regarding claim 11, Majumdar et al. disclose that the heat sink 1 is sheet-shaped (fig. 9).

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hamzehdoost et al. (U.S. Pat. 5430331) (newly cited) in view of McCarthy et al. (U.S. Pat. 3956726) (previously applied).

Hamzehdoost et al. substantially discloses all the limitations as claimed above except the module further comprising a heat detection circuit.

However, McCarthy et al. disclose a device comprising a heat detection circuit (column 1, lines 39-42). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Hamzehdoost et al. by having a heat detection circuit, as taught by McCarthy et al., such the heat detection circuit would detect the heat produced by the semiconductor element for the package device (column 1, lines 39-42).

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hamzehdoost et al. (U.S. Pat. 5430331) (newly cited) in view of Tomita et al. (U.S. Pat. 5440169) (previously applied).

Hamzehdoost et al. substantially discloses all the limitations as claimed above except the heat sink is adhered to at least one of the lead frame and the sealer with an adhesive.

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However, Tomita et al. disclose a heat sink 30 is adhered to at least one of the lead frame and a sealer 6 with an adhesive of a plurality of dimples 25 (fig. 8, column 5, lines 35-60). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Hamzehdoost et al. by having the heat sink is adhered to the lead frame and the sealer with an adhesive, as taught by Tomita et al., in order to improve the molding characteristics for the semiconductor package (column 5, lines 60 et seq.).

9. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hamzehdoost et al. (U.S. Pat. 5430331) (newly cited) in view of Tomita et al. (U.S. Pat. 5440169) (previously applied) and further in view of Majumdar et al. (U.S. Pat. 5703399) (previously applied).

As discussed in details above, the combination of Hamzehdoost et al. and Tomita et al. substantially disclose all the limitations as claimed above except the adhesive contains a filler that includes at least one compound selected from the group consisting of Al_2O_3 , AlN and BeO .

However, Majumdar et al. disclose a highly heat conducting resin 2, wherein the adhesive contains a filler that includes at least one compound selected from the group consisting of AlN (column 8, lines 22-34). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select AlN for the filler in the adhesive of the above combination because as taught by Majumdar et al., such the filler in the adhesive would provide a highly heat conducting resin with an excellent electric insulating property and thermal conductivity (column 8, lines 25-34).

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10. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hamzehdoost et al. (U.S. Pat. 5430331) (newly cited).

Hamzehdoost et al. discloses a semiconductor package comprising:

a lead frame 154 having a first portion 152 at a first level, a second portion connected to the first portion at a second level, and a plurality of terminals connected to the second portion;

a power circuit 150 mounted on a first surface of the first portion;

a heat sink 144 or 130 having an electrically insulating property and thermal conductivity, wherein the heat sink directly contacts a second surface opposite the first surface of the first portion of the lead frame; and

a sealer having an electrically insulating property and thermal conductivity, wherein the sealer covers the power circuit (cover fig. and fig. 14A, column 9, lines 17-21).

Hamzehdoost et al. do not explicitly disclose that the heat sink comprising at least one compound selected from the group consisting of Al_2O_3 . However, Hamzehdoost et al. disclose that the heat sink 130 or 144 is formed of an aluminum nitride material, although any of the numerous other similar ceramic-type substrate materials well known in the art are suitable (column 6, lines 23-26). Moreover, selection of a known material based on its suitability for its intended use supported a prima facie obviousness determination in *Sinclair & Carroll Co., Inc. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945).

Response to Arguments

Applicant's arguments with respect to claims 1-6, 8-11 and 19 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DiLinh Nguyen whose telephone number is (571) 272-1712. The examiner can normally be reached on 8:00AM - 6:00PM (M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy can be reached on (571) 272-1705. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DLN

A handwritten signature in black ink, appearing to read 'Hoai Pham', with a long horizontal flourish extending to the right.

HOAI PHAM
PRIMARY EXAMINER